

Appl. No. 09/706,326  
Atty. Docket No. 8321  
Amdt. dated May 1, 2006  
Reply to Office Action of December 1, 2005  
Customer No. 27752

## REMARKS

### Claim Status

Claims 1 - 35 are pending in the present application. No additional claims fee is believed to be due.

Claims 1, 32 and 34 have been amended to change to more particularly point out and distinctly claim the subject matter of Applicant's invention, and to more specifically characterize the relationship of the elements of the invention. Support for these amendments can be found at page 5, lines 1-20; of the specification, and in Claims 1, 32 and 34 as originally filed.

### Rejections

Claims 1-3, 6-7, and 11-31 were rejected under 35 USC §102(b) as being unpatentable over Rongley (US 5,758,322). Claims 4-5 were rejected under 35 USC §103(a) as being unpatentable over Rongley (US 5,758,322), in view of Otto (US 5,703,943). Claims 8-10 were rejected under 35 USC §103(a) as being unpatentable over Rongley (US 5,758,322), in view of Dragosh et al. (US 6,078,886). The Examiner asserts that Claims 32-35 teach a method similar in scope and content to the other claims and are rejected under similar rationale.

Rongley discloses systems and methods for conducting point-of-sale transactions using voice recognition techniques (Col. 1, lines 7-10). The systems and methods disclosed in Rongley are particularly focused on point-of-sale transactions using voice recognition techniques in food service establishments. Otto discloses a (Col. 2, lines 21-28). Dragosh discloses (Col. 1, lines 62-65). For the reasons set forth below these rejections are respectfully traversed.

#### I. Rejection Under 35 USC 102(b) Over Rongley (US 5,758,322)

Claims 1-3, 6-7 and 11-31 were rejected under 35 USC §102(b) as anticipated by Rongley, US Patent No. 5,758,322 ("Rongley"). For the reasons set forth below, the rejection is respectfully traversed.

Appl. No. 09/706,326  
Atty. Docket No. 8321  
Amdt. dated May 1, 2006  
Reply to Office Action of December 1, 2005  
Customer No. 27752

Rongley discloses systems and methods for conducting point-of-sale transactions using voice recognition techniques (Col. 1, lines 7-10), with particular emphasis on point-of-sale transactions using voice recognition techniques in food service establishments. In making the rejection, the Examiner contended that Rongley teaches each and every element of the rejected claims. Applicant respectfully asserts that this position is in error and that the rejection should be reversed.

As is well settled, anticipation requires "identity of invention." *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claim. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

Furthermore, in a §102(b) rejection there must be no difference between what is claimed and what is disclosed in the applied reference. *In re Kalm*, 154 USPQ 10, 12 (CCPA 1967); *Scripps v. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). "Moreover, it is incumbent upon the Examiner to *identify wherein each and every facet* of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 USPQ2d 1461, 1462 (BPAI 1990). The Examiner is required to point to the disclosure in the reference "*by page and line*" upon which the claim allegedly reads. *Chiong v. Roland*, 17 USPQ2d 1541, 1543 (BPAI 1990).

Moreover, there is a "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103. . . ." *In re Warner*, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

Furthermore, "it is incumbent upon the Patent Office . . . to set forth clearly why it regards a claim to be anticipated . . . ." *In re Mullin*, 179 USPQ 97, 100 (CCPA 1973). A rejection may not merely assert that a particular reference anticipates a claim. For example, in *Mullin*, the court found the Examiner's assertion that "[c]laims 1-5 are rejected as obviously anticipated by [a reference] under 35 U.S.C. 102" did not necessarily inform the applicant why the claims were regarded as defective. (*Id.* at 100.).

The present rejection fails to set forth a *prima facie* case of anticipation because Rongley does not contain an identity of invention in that it fails to teach each and every

Appl. No. 09/706,326  
Atty. Docket No. 8321  
Amdt. dated May 1, 2006  
Reply to Office Action of December 1, 2005  
Customer No. 27752

element of Applicant's recited claims. Specifically, Rongley fails to disclose Applicant's claimed element of presenting a representation of the computer transaction to a human operator.

The Office Action contends that Rongley discloses, at Col. 4, lines 20-28, Applicant's claimed element of presenting a representation of the computer transaction to a human operator. However, Applicant respectfully asserts that such a contention is in error.

Applicant's Specification, at page 5, lines 6-7, defines a user (e.g., a consumer) as the person who initiates contact with the syntax-driven voice recognition system of the present invention. Applicant's Specification, at page 5, lines 16-20, clearly describes the human operator as a system operator who reviews the voice file provided by the user (or "speaker" ) and the transaction for accuracy, makes any necessary corrections in the transaction based on information from the user's voice file, and sends the finalized transaction to a target system for processing. Reading Applicant's rejected claims as amended in light of these descriptions in the Specifications, it is clear that the user and the human operator are separate individuals. Claims 1, 32 and 35 have been amended to more clearly make this distinction.

In stark contrast, as previously detail by Applicant, Rongley discloses systems and methodologies for conduction point-of-sale transactions that do not employ a separate human operator in the transaction. At Col. 4, Lines 20-28, Rongley discloses a system for use in a fine dining establishment where a waiter, using voice recognition techniques, inputs items to be ordered into a microphone connected to a register PC. The items to be ordered, once inputted in such a fashion by the waiter (e.g., "speaker"), is then displayed back to the waiter (e.g., "speaker") for verification, as opposed to a separate individual. Similar processes, whereby information is entered by a user (e.g., a waiter) are subsequently reviewed by the same user (e.g., the same waiter), as opposed to a separate individual, are disclosed throughout Rongley (see Col 10, line 62 – Col. 11, line 6).

Applicant's contend that the cited disclosure of Rongley (Col. 4, Lines 20-28) does not establish a *prima facie* case of anticipation as the reference does not teach each and every element of Applicant's claimed invention. Accordingly, Applicant asserts that

Appl. No. 09/706,326  
Atty. Docket No. 8321  
Amdt. dated May 1, 2006  
Reply to Office Action of December 1, 2005  
Customer No. 27752

continued rejection of the claims on these grounds would be in error and should be withdrawn.

**II. Rejection Under 35 USC 103(a) Over Rongley (US 5,758,322), in view of Otto (US 5,703,943)**

Claims 4-5 were rejected under 35 USC §103(a) as being unpatentable over Rongley (US 5,758,322), in view of Otto (US 5,703,943). Applicants respectfully traverse this rejection as the reference combination of Rongley and Otto does not teach each and every element of the claimed invention as is required (see MPEP 2143.03) and therefore does not establish a *prima facie* case of obviousness. Therefore, Applicants' assert that the claimed invention is unobvious and that the rejection should be withdrawn.

The Rongley reference discloses systems and methods for conducting point-of-sale transactions using voice recognition techniques (Col. 1, lines 7-10), with particular emphasis on point-of-sale transactions using voice recognition techniques in food service establishments. Rongley further discloses a system for use in a fine dining establishment where a waiter, using voice recognition techniques, inputs items to be ordered into a microphone connected to a register PC. The items to be ordered, once inputted in such a fashion by the waiter, is then displayed back to the waiter for verification, as opposed to a separate individual (Col. 4, Lines 20-28). Rongley does not disclose, teach nor suggest the use of a distinct human operator who is presented a representation of a computer transaction between the waiter and system for verification and error correction.

The Otto reference discloses a system for routing calls to a preferred a transaction agent, when available, or an alternate transaction agent when the preferred agent is unavailable (Abstract; Col 2, lines 11-18). Though the disclosure in Otto relates generally to the phone based transactions, it does not disclose, teach nor suggest Applicant's claimed process of utilizing human operators and voice recognition techniques to efficiently and expeditiously complete phone transactions.

Applicant's contend that the reference combination of Rongley and Otto does not establish a *prima facie* case of obviousness as the reference combination does not teach each and every element of Applicant's claimed invention. Accordingly, Applicant asserts

Appl. No. 09/706,326  
Atty. Docket No. 8321  
Amdt. dated May 1, 2006  
Reply to Office Action of December 1, 2005  
Customer No. 27752

that continued rejection of the claims on these grounds would be in error and should be withdrawn.

**III. Rejection Under 35 USC 103(a) Over Rongley (US 5,758,322), in view of Otto (US 5,703,943)**

Claims 8-10 were rejected under 35 USC §103(a) as being unpatentable over Rongley (US 5,758,322), in view of Dragosh et al. (US 6,078,886). Applicants respectfully traverse this rejection as the reference combination of Rongley and Dragosh does not teach each and every element of the claimed invention as is required (see MPEP 2143.03) and therefore does not establish a *prima facie* case of obviousness. Therefore, Applicants' assert that the claimed invention is unobvious and that the rejection should be withdrawn.

The Rongley reference discloses systems and methods for conducting point-of-sale transactions using voice recognition techniques (Col. 1, lines 7-10), with particular emphasis on point-of-sale transactions using voice recognition techniques in food service establishments. Rongley further discloses a system for use in a fine dining establishment where a waiter, using voice recognition techniques, inputs items to be ordered into a microphone connected to a register PC. The items to be ordered, once inputted in such a fashion by the waiter, is then displayed back to the waiter for verification, as opposed to a distinct individual (e.g., "human operator") (Col. 4, Lines 20-28). Rongley does not disclose, teach nor suggest the use of a distinct human operator who is presented a representation of the waiter's computer transaction for verification and error correction.

The Dragosh reference discloses a system for utilizing voice recognition over a packet network such as the Internet without the need for separate hardware (Abstract; Col 2, lines 54-61). Though the disclosure in Dragosh relates generally to speech recognition techniques, it does not disclose, teach nor suggest Applicant's claimed process of utilizing human operators and voice recognition techniques to efficiently and expeditiously complete phone transactions.

Applicant's contend that the reference combination of Rongley and Dragosh does not establish a *prima facie* case of obviousness as the reference combination does not

Appl. No. 09/706,326  
Atty. Docket No. 8321  
Amdt. dated May 1, 2006  
Reply to Office Action of December 1, 2005  
Customer No. 27752

teach each and every element of Applicant's claimed invention. Accordingly, Applicant asserts that continued rejection of the claims on these grounds would be in error and should be withdrawn.

#### Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections under 35 USC 102(b) and 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicant respectfully requests reconsideration of this application and allowance of Claims 1-35.

Respectfully submitted,  
Theodore Van Fossen McConnell

By 

Erich D. Hemm  
Attorney for Applicant(s)  
Registration No. 47,286  
(513) 634-8960

May 1, 2006  
Customer No. 27752

Appl. No. 09/706,326  
 Atty. Docket No. 8321  
 Amdt. dated May 1, 2006  
 Reply to Office Action of December 1, 2005  
 Customer No. 27752

**REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED  
 COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003**

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: Changes To Implement Electronic Maintenance of Official Patent Application Records (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at <http://www.uspto.gov/web/patents/lsw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period. ***Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.***

Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.  
**REVISED AMENDMENT PRACTICE**

**I. Begin each section of an amendment document on a separate sheet:**

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

**II. Two versions of amended part(s) no longer required:**

37 CFR 1.121 has been revised to no longer require two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for substitute specifications under 37 CFR 1.125 have been retained.

**A) Amendments to the claims:**

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, must include a complete listing of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and the text of each pending claim (with markings to show current changes) must be presented. The claims in the listing will replace all prior claims in the application.

(1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), (previously presented) and (not entered). The text of all pending claims, including withdrawn claims, must be submitted each time any claim is amended. Canceled and not entered claims must be indicated by only the claim number and status, without presenting the text of the claims.

(2) The text of all claims being currently amended must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., ~~[[error]]~~); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., ~~[[4]]~~). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.

(3) The text of pending claims not being currently amended, including withdrawn claims, must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

06/30/03 Flyer for mailing with all Office actions by all TCs (4) A claim being canceled must be listed in the claim listing with the status identifier "canceled"; the text of the claim must not be presented. Providing an instruction to cancel is optional.

(5) Any claims added by amendment must be presented in the claim listing with the status identifier "(new)"; the text of the claim must not be underlined.

(6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (e.g., Claims 1 - 5 ((canceled))).

Example of listing of claims (use of the word "claim" before the claim number is optional):

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a green blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Appl. No. 09/706,326  
 Atty. Docket No. 8321  
 Amdt. dated May 1, 2006  
 Reply to Office Action of December 1, 2005  
 Customer No. 27752

Claim 11 (canceled)  
 Claim 12 (not entered)  
 Claim 13 (new): A bucket with plastic sides and bottom.

**B) Amendments to the specification:**

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125. The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., ~~[[error]]~~); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., ~~[[4]]~~). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as).

**C) Amendments to drawing figures:**

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. Any marked-up (annotated) copy showing changes must be labeled "Annotated Sheet Showing Changes" and accompany the replacement sheet as an appendix to the amendment. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to [patent.practice@uspto.gov](mailto:patent.practice@uspto.gov) or by phone at (703)305-1616.

06/30/03 Flyer for mailing with all Office actions by all TCs